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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,747	11/20/2000	Benyahia Nasli-Bakir		4239

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,747

Applicant(s)

NASLI-BAKIR ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-46 and 56-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-46 and 56-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's (compliant) submission filed on 22 August 2005 has been entered.

Response to Amendment

2. To clarify the record at this point in the prosecution, claims 39-46 and 56-95 are pending.

Response to Arguments

3. Applicant's arguments filed in the above-mentioned submission have been fully considered but they are not persuasive.

Applicant has yet to traverse the objection to the title, first set-forth in the Office action mailed 17 December 2002. This objection is maintained.

Applicant has not traversed the rejections of claim 94 under 35 U.S.C. § 112, 1st and 2nd Paragraphs, set-forth in the Office action mailed 14 January 2005. These rejections are maintained.

Applicant has failed to specify how the combination(s) of references in the Office action of 14 January 2005 fail(s) to teach the invention as recited in the claims. These rejections are maintained.

New claim 95 is rejected for the reasons set-forth below.

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Obviousness-type double patenting rejections are set-forth below in view of US 6,734,275 A.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD OF SEPARATE APPLICATION OF RESIN AND HARDENER COMPONENTS OF AN AMINO RESIN GLUING SYSTEM.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 94 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This claim is rejected for the same reasons set-forth under this heading in the Office action mailed 14 January 2005.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. **Claim 94 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

This claim is rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 39, 41-46, 56-59, 70-76, 78-93, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perciwall (EP 0 016 740 A1) in view of Andersson (EP 0 207 024 A2).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

With respect to new claim 95, Perciwall teaches that “preferably the hardener component...does not contain any thickening additives” (5:20-22). It is clear from this teaching

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that, although not preferred, thickeners may be present in the hardener. Further, Perciwall is silent with respect to whether or not the hardener comprises a filler. Based on this fact, it is the examiner's position that one of ordinary skill in the art would have reasonably interpreted the hardener of Perciwall as free from filler. Please note: a filler amount of less than a certain % by weight is inclusive of no filler at all.

12. Claims 40 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perciwall (EP 0 016 740 A1) in view of Andersson (EP 0 207 024 A2) as applied to claims 39 and 76, respectively, above, and further in view of Menger (US 2,015,806 A).

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

13. Claims 60 – 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perciwall (EP 0 016 740 A1) in view of Andersson (EP 0 207 024 A2) and Toshio (JP 61-040137).

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

14. Claims 39, 41 – 45, 56 – 59, 70 – 76, 78 – 82, 84 – 87, and 89 – 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (US 0 207 024 A2) in view of Lehnert (WO 89/05221 A1).

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

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15. **Claims 46, 83, and 88 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1), as applied to claims 49, 80, and 87, respectively, above, in further view of Perciwall (EP 0 016 740 A1).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

16. **Claims 40 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1) as applied to claims 39 and 76, respectively, above, and further in view of Menger (US 2,015,806 A).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

17. **Claims 60 – 64 and 66 – 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1) and Toshio (JP 61-040137).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

18. **Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1) and Toshio (JP 61-040137), as applied to claim 60 above, in further view of in further view of Perciwall (EP 0 016 740 A1).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

19. **Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perciwall (EP 0 016 740 A1) in view of Andersson (EP 0 207 024 A2).**

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These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

20. **Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1) and Perciwall (EP 0 016 740 A1).**

These claims are rejected for the same reasons as set-forth under this heading in the Office action mailed 14 January 2005.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. **Claims 70 and 76 are each rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Andersson (EP 0 207 024 A2).**

Claim 70

The patented claims generally recite a method of separate application of resin and hardener components of an amino resin gluing system onto a substrate, wherein the hardener comprises an acid. The patented claims are silent with respect to the presence of filler, which the examiner interprets as a fair teaching that the hardener of the patented claims do not comprise

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any filler. (Please note that the patented specification states: "The hardener composition may, optionally, comprise fillers, thickeners or other additives" (4:39-41). This is a clear teaching that the hardener may, optionally, contain no filler.)

Patented claims 1 and 18 differ from instant claim 70 in that the patented claims do not explicitly state that: (i) the substrate is not explicitly defined as wood; (ii) the acid is not explicitly defined as "volatile;" and (iii) the resins and hardener are applied as strands of hardener that do not overlap.

With respect to (i), instant claim 70 is broader than patented claim 1 and, as such, fully encompasses the wooden substrate of the patented claim. Further, the instant specification discloses application to wooden substrates (2:20-25).

With respect to (ii), the patented specification explicitly discloses, as examples of the acid, acetic and hydrochloric (4:1-27). The instant specification gives these acids as examples of suitable "volatile" acids (4:top). It would have been obvious to one of ordinary skill in the art to modify the method of patented claims 1 and 18 so as to utilize, as the acid, the explicitly disclosed acetic or hydrochloric volatile acids. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of providing a suitable acid for the hardener component.

With respect to (iii), Andersson teaches a method of applying a two-component gluing system to a substrate in which the resin component and the hardener component are separately applied to the substrate in the form of separate, parallel strands (abstract). The components do not contact each other until the surfaces are joined together (6:15-17). It would have been obvious to one of ordinary skill in the art to modify the method of instant claims 1 and 18 so as

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to apply the components in the form of separate, parallel strands, as taught by Andersson. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of preventing pre-curing of the adhesive to the greatest extent possible.

Patented claim 9 additionally differs from instant claim 70 in that the patented claim does not teach that the resin and hardener components are applied separately.

Again, as noted above, it would have been obvious to one of ordinary skill in the art to keep the resin and hardener component separate for as long as possible in order to prevent premature curing.

Claim 76

The teaching of the patented claims is detailed above, and this claim is rejected for the same reasons as detailed above. As noted above, the hardener composition may, optionally, comprise fillers, thickeners or other additives" (4:39-41). This is a clear teaching that the hardener may, optionally, contain a thickener.

23. Claim 94 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Perciwall (EP 0 016 740 A1) and Andersson (EP 0 207 024 A2).

Claim 94

The teaching of the patented claims is detailed above. As noted above, the hardener composition may, optionally, comprise fillers, thickeners or other additives" (4:39-41). This is a clear teaching that the hardener may, optionally, contain a thickener.

The patented claims differ from instant claim 94 in that the patented claims do not explicitly state that: (i) the later applied strands do of one component substantially overlap the

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corresponding previously applied strands of the other component; (ii) the hardener component is applied on top of the resin component; and (iii) the volatile component of the hardener comprises formic acid in an amount of 10-30% by weight.

With respect to (iii), Perciwall teaches a method of applying a gluing system to a substrate, the gluing system having an amino resin component and an acid hardener component (abstract and 4:24-5:22). The gluing system is specifically a urea-based system (1:2-2:34, for example; 4:24-33; and 8:2-6). It would have been obvious to one of ordinary skill in the art to modify the process of Perciwall so as to utilize, as the hardener component, a formic acid-containing hardener. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully hardening the gluing system. Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical (see MPEP § 2144.05(II)(A)). Further, it is the examiner's position that the amount of volatile acid in the hardener composition will effect the setting time of the resin component, and will depend on other components present in the hardener composition, as well as the substrate to which the composition is applied. Volatile acid concentration is, therefore, a result-effective variable. Absent clear and convincing evidence of unexpected results demonstrating the criticality of the claimed volatile acid concentration, it would have been obvious to one of ordinary skill in the art to optimize such a result-effective variable by routine experimentation (see MPEP § 2144.05(II)(B)).

With respect to (i) and (ii), Andersson teaches a method of applying a two-component gluing system to a substrate in which the resin component and the hardener component are separately applied to the substrate in the form of separate, parallel strands (abstract). The

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components do not contact each other until the surfaces are joined together (6:15-17). It would have been obvious to one of ordinary skill in the art to modify the method of patented claims 1 and 18 so as to apply the components in the form of separate, parallel strands, as taught by Andersson. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of preventing pre-curing of the adhesive to the greatest extent possible. Nevertheless, it is clear that, as soon as the components are mixed together, curing begins. The particular physical orientation of the strands on the substrate effect the speed and degree of curing; such would have been readily apparent to one of ordinary skill in the art. Consequently, absent clear and convincing evidence to the contrary, it would have been obvious to one of ordinary skill in the art to select the orientation of resin and hardener strands to give the desired curing rate and substrate coverage. In other words, for a quicker cure, strands are applied with a greater degree of overlap so that curing may begin before the substrates are joined.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/29/2005

William Phillip Fletcher III
Patent Examiner, USPTO
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